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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicants	:	Jon C. Zaring et al.		
Application No.	:	09/516,736	Confirmation No. :	3221
Filed	:	March 1, 2000		
For	:	CELLULAR TELEPHONE INTERACTIVE WAGERING SYSTEM		
Group Art Unit	:	3639		
Examiner	:	Richard S. Woo		

Mail Stop AF
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Pursuant to 1296 Off. Gaz. 2 (July 12, 2005), applicants request review of the final rejection of claims 1-71 in the above-identified application. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal.

Arguments begin on page 2 of this paper.

ARGUMENTS

I. Summary of Office Action

Claims 1-71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brenner et al. U.S. Patent No. 6,099,409 (hereinafter "Brenner") in view of LaDue U.S. Patent No. 5,999,808 (hereinafter "LaDue").

II. Summary of Arguments

For the purposes of this Request, applicants are not addressing the inappropriateness or lack of motivation to combine Brenner with LaDue. Although applicants feel there are strong and valid arguments to make on these fronts, applicants instead will reiterate the clear legal deficiencies in the 35 U.S.C. § 103(a) rejection of claims 1-71 in the July 1, 2005 final Office Action (hereinafter "Office Action"). Namely, applicants will show that the Examiner has failed to establish a *prima facie* case of obviousness in view of Brenner and LaDue because all of applicants' claimed limitations are not disclosed or suggested in the prior art. Applicants reserve the right to present additional arguments, including arguments on the lack of sufficient motivation to combine Brenner and LaDue, upon the decision of the panel review.

III. The Examiner Has Failed to Establish a *Prime Facie* Case of Obviousness

Applicants' independent claims 1, 32, 35, 36, 37, 40 and 41 are generally directed toward interactive wagering on races with a cellular telephone. Racing data on races that have not been run and that a user is allowed to place wagers on are received at the cellular telephone. A user is allowed to select to present the racing data in audio form or visual form and the racing data is presented on the cellular telephone based on the user selection.

Generally speaking, Brenner refers to systems and methods for interactive off-track wagering. Brenner, however, as admitted in the Office Action, "does not expressly disclose the method for interactive wagering utilizing a cellular telephone that is in a wireless data communications network" or a selection to present racing data in audio or visual form (Office Action, page 4).

LaDue refers to a wireless gaming method that utilizes a wireless communications network. FIG. 9 of LaDue shows a gaming system console with a built-in liquid crystal display. Full color gaming data, including video, images, and advertisements, may be presented on the console's display. The gaming console also includes a speaker and microphone for placing cellular telephone calls to an operator or control center. (See LaDue, column 10, lines 40-65).

The Examiner admits that LaDue's gaming console "does not expressly show the selecting option [to receive the incoming racing data in audio form or visual form] (Office Action, page 2). Nevertheless, the Examiner contends that the device of Brenner as modified with LaDue "would allow the user to select to present the data in audio form or visual form" (Office Action, page 2). Applicants respectfully disagree.

Applicants submit that LaDue merely shows two distinct ways to process <u>two different types of information</u>. Gaming data is received and displayed on the console's liquid crystal display, while telephone calls are received and played on the console's speaker. LaDue in no way discloses or suggests "allowing the user to select to present the racing data in audio form or video form" as in applicants' claimed invention. Rather, in LaDue's gaming method, telephone voice data is presented audibly on a speaker and gaming data is presented visually on a liquid crystal display. (See column 10, line 40 to column 11, line 24). LaDue's method does not

include a step for selecting a data format indication for presenting the received gaming data in either audio form or video form.

The Examiner also contends that LaDue's device is based on "traditional cellular phone technology in which the user is allowed to select to receive the incoming data in audio form or video form" (Office Action, page 2). Once again, applicants respectfully submit that the Office Action is in error.

Applicants do not believe that such functionality existed in traditional cellular telephone technology. Although a traditional cellular telephone may be capable of processing both audio and video signals, a cellular telephone user is not presented with an option to "select to present . . . data in audio or visual form" as required by applicants' independent claims. Rather, for example, incoming text messages are displayed visually to a cellular telephone user, while incoming telephone calls are presented audibly. A user of traditional cellular telephone technology, however, is not given an opportunity to present an incoming telephone call visually, just as the user is not given an opportunity to present an incoming text message audibly.

For at least for the above reasons, applicants submit that the Examiner has misconstrued LaDue and traditional cellular telephone technology. It is well established that "to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art" (MPEP § 2143.03). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The combination of Brenner and LaDue (or traditional cellular telephone technology) clearly fails to disclose or suggest at least the selection of presenting racing data in audio form or visual form. Accordingly, the Examiner's rejection under 35 U.S.C. § 103(a) is insufficient as a matter of law.

For at least the foregoing reasons, applicants respectfully request that the panel issue a written decision withdrawing the rejection of claims 1-71 under 35 U.S.C. § 103(a).

IV. Conclusion

For the reasons set forth above, claims 1-71 are patentable in view of Brenner and LaDue. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,

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